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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/802,472	02/18/1997	CHARLES KORMANIK JR.		7544

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EXAMINER

LUBY, MATTHEW D

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/802,472

Applicant(s)

KORMANIK, CHARLES

Examiner

Matt Luby

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-15 and 17-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 8-15 and 17-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/6/1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Art Unit Change

1. Applicant is requested to note that the Examiner's Art Unit changed over 3 years ago and it is requested that Applicant please direct all communication in the future to Art Unit 3611 instead of Art Unit 3208, which has never been the Examiner's Art Unit.

Response to Board Decision

2. In response to the Board's decision, Applicant filed an amendment (Paper 35, received 10/21/02), which amended claims 5 and added new claims 32-48. This is improper under MPEP 1214.07 because the Board did not make a new rejection under 37 CFR 1.196(b) but merely remanded to the examiner for consideration of art. Since the Board only remanded, prosecution on the merits of the application is closed and the amendment has not been entered. However, the examiner has considered the references listed on pages 6-8 of the Board's decision and is re-opening prosecution on the merits to make a new rejection in accordance with the Board's recommendations (see below).

Election/Restrictions

3. Claims 1-4 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking

claim. Election was made **without** traverse in Paper No. 9 and affirmed in Paper No. 14.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5, 8-15 and 17-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation "the shape of the package visually conveying information about an activity associated with the icon in which the article is in use" (lines 5-6, claim 5) is vague and indefinite. This limitation is entirely subjective. It is therefore unclear what information about what activity in connection with the icon is conveyed. It is further unclear whether this activity has any limitations or if it could be any activity imagined by any potential user of the device in associated with the article therein. For example, looking at a backpack which might have any type of climbing or hiking equipment therein, one could imagine that the shape of the backpack visually conveys information about hiking/climbing (which is associated with backpacks) in which the article(s) in the backpack are used (such as climbing poles, extra hiking socks or whatever fanciful subjective interpretation the reader of the claim may daydream.) Hence, the claim is ultimately a subjective choice by the reader of the claim.

Therefore, claim 5 is interpreted to mean a method for making a package that is shaped like any kind of imaginable symbol, wherein the package contains an article shaped differently from the package itself and the outside shape of the package can be interpreted to represent any kind of imaginable activity associated with the shape of the package and the article contained therein, wherein the package has a hollow interior whereby the method is completed by locating the article in the hollow interior.

The limitations "the object being a member of the group..."; "wherein the step of locating the article within the packaging further includes the step of locating rain gear" and "locating rain gear, as the article, within the packaging..." (claim 24, lines 9-13; claim 25, lines 21-28 and claim 26, lines 27-31) are vague and indefinite because it is unclear what this limitation has to do with the preamble of the claim, i.e., a method of making packaging/thematically-shaped packaging. This limitation is vague and indefinite because it is unclear what, if anything, the contents inside a package, have to do with the method of making the packaging. In other words, if an applicant were filing a patent application for a method of making a cardboard box, the claim would be clear by reciting a method of constructing the package but would be vague and indefinite if it were drawn to the actual contents of the package.

The limitation "packaging the package..." (claim 27) is vague and indefinite because it is unclear what the limitation has to do with the preamble of the claim, i.e., a method of making a package. This limitation is vague and indefinite because it is unclear what, if anything, the subsequent packaging of an already made package has to

do with the method of making that first package itself. Furthermore, this appears to just be a duplicative limitation.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 5, 9, 11, 13, 20-22 and 28-31 as best understood (the claim is rejected as has been interpreted in the last paragraph of the 112, 2nd paragraph rejection above), is rejected under 35 U.S.C. 102(b) as being anticipated by Gossard (U.S. Patent 3,624,939).

Gossard discloses a method for making a package that is shaped like any kind of imaginable symbol (here the package is made to be shaped like a baseball), wherein the package contains a plastic article shaped differently from the package itself (photographs, 16, of baseball players, which can be made from plastic), engaging lips on the inside of the package to encase the article (17) and the outside shape of the package can be interpreted to represent any kind of imaginable activity associated with the shape of the package and the article contained therein (here, this is interpreted to mean the broad, sweeping activity of collecting sports memorabilia), wherein the package has a hollow interior (see Figure 2, for example) and the outside of the package has engaging lips (on 11 and 12, see Figures 1-3, for example) whereby the

method is completed by locating the article in the hollow interior (see Figures 1-3, for example), wherein the replica is constructed by cutting out of plastic (since the replica can be made of plastic, it must be constructed from plastic) to have additional utility (a ball to be played with) which can receive writing from a pen or magic marker thereon (Figure 1 shows a replica that can receive writing from a pen or magic marker thereon) and constructing the replica as a baseball, football or soccer ball (see Figures 1, 3 and 11) to be a toy.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8, 10, 12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gossard.

While Gossard discloses making a package shaped like a baseball, football or soccer ball, there is no specific disclosure to making the package in the shape of a golf ball, a life preserver, a tennis ball, a rugby ball or a charge/bank car (in accordance with claims 8, 10, 12, 14 and 17). It would have been an obvious matter of design choice to make the package in the shape of whatever desirable or creative packaging the manufacturer intends to market to the target audience since shapes of packages are considered a mere matter of the marketing process (this is clearly evident from the

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multiple marketing target shapes present in the Gossard patent) and since applicant has failed to disclose that the limitation solves any stated problem. *In re Kuhle*, 188 USPQ 7, CCPA 1975. Furthermore, it would have been an obvious matter of design choice to make the package of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. Still further, Gossard specifically mentions at lines 20-25 that the container shapes depicted are merely exemplary of the most common sports and therefore it is well within the scope of Gossard to have the container be shaped to represent any sport associated with the photograph contained therein.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gossard in view of Francis (U.S. Design Patent 346,185).

Gossard discloses all of the claimed invention except for locating a logo on the replica. Francis discloses that it is notoriously well known in the art of packages to place a logo thereon (see Figure 1) in order to represent what the package contains (this is possibly the oldest, inherent characteristic of packages - e.g., wording that describes what is inside the package). It would have been obvious to one of ordinary skill in the art at the time of the invention to locate a logo on the Gossard package, as taught by Francis in order to represent what the package contains.

11. Claims 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gossard.

Gossard discloses all of Applicant's claimed invention but does not specifically disclose adding an outer layer of packaging also shaped to visually convey information about the associated activity. It would have been an obvious matter of design choice to add an outer layer of packaging also shaped to visually convey information about the associated activity since this is an inherently old and well known concept in the art of packaging/marketing (i.e., adding a plastic bubble enclosing the contents for sale in a store as well as for shipping purposes, to protect the contents, and also printing the contents or various characteristics of the contents on the outside layer of packaging, which in the instant case may include: "Baseball shaped sports memorabilia Bank" or a similar phrase, along with the location of the manufacturer). *In re Kuhle*, 188 USPQ 7, CCPA 1975.

12. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gossard in view of Schaffer (US Design Patent 196,679).

Gossard discloses all of Applicant's claimed invention except for a means for attaching the replica to another article. Schaffer discloses a means for attaching the replica to another article (the carrying chain, shown in Figures 1-3) in order to provide a convenient carrying mechanism (the inherent value in a carrying chain, which may be attached to a key ring, for example). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a means for attaching the replica to another article on the Gossard method as taught by Schaffer in order to provide a convenient carrying mechanism.

Allowable Subject Matter

13. Claim 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art fails to disclose a method of making a combination of a thematic package and an article contained therein which includes an outer layer that has a sleeve for golf balls.

14. Claims 24-26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action. The prior art fails to disclose a method for making thematically-shaped package including the step of locating rain gear inside of the package along with the rest of the recited limitations of claims 24-26.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure because it all relates to thematically shaped packages.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matt Luby whose telephone number is (703) 305-0441. The examiner can normally be reached on Monday-Friday, 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Matt Luby
Examiner
Art Unit 3611



M.L.
March 7, 2003



Lesley D. Morris
~~Primary Examiner~~

SPE Au3611